

## **REMARKS**

Applicants respectfully request entry of the following amendments and remarks contained herein in response to the Office Action mailed May 16, 2005. Applicants respectfully submit that the amendment and remarks contained herein place the instant application in condition for allowance.

Upon entry of the amendments in this response, claims 1 – 27 remain pending. In particular, Applicants amend claims 1 – 11, 13 – 19, 21 – 23, and 26 – 27. Reconsideration and allowance of the application and presently pending claims are respectfully requested.

### **I. Amendments to the Written Description**

The Office Action indicates that the Written Description is objected to because of various informalities. Applicants amend the Written Description, as indicated above, and submit that no new matter is added.

### **II. Rejections Under 35 U.S.C. §112**

The Office Action indicates that claims 4, 13 – 14, and 16 stand rejected under 35 U.S.C. §112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicants regard as the invention. In response to the Office Action's request, Applicants amend claims 4, 13 – 14, and 16. Applicants submit that these amendments comply with the Office Action's request and that claims 4, 13 – 14, and 16 are in condition for allowance.

### III. Rejections Under 35 U.S.C. §102

A proper rejection of a claim under 35 U.S.C. §102 requires that a single cited art reference disclose each element of the claim. *See, e.g., W.L. Gore & Assoc., Inc. v. Garlock, Inc.*, 721 F.2d 1540, 220 USPQ 303, 313 (Fed. Cir. 1983).

#### A. Claim 1 is Patentable Over Clark

The Office Action indicates that claim 1 stands rejected under 35 U.S.C. §102(e) as allegedly being anticipated by U.S. patent number 6,442,588 to Clark et al. (“*Clark*”).

Applicants respectfully traverse this rejection on the grounds that *Clark* does not disclose, teach, or suggest all of the claimed elements. Claim 1, as amended recites:

A method for blocking unsolicited e-mail transmitted to an e-mail server at an Internet Service Provider (ISP), the method comprising:  
receiving a user identification (USERID) and a password associated with a customer;  
retrieving a plurality of data associated with the customer based on the USERID and password;  
authenticating the customer using the retrieved plurality of data;  
dynamically adding an IP address assigned to the customer to a plurality of valid IP addresses associated with the ISP;  
receiving SMTP traffic from the customer;  
***in response to receiving the SMTP traffic, determining, at the e-mail server, whether the customer is associated with a valid IP address;***  
***and***  
in response to determining that the customer is associated with a valid IP address, logging the customer onto the e-mail server using the IP address and the plurality of data used to authenticate the customer, wherein only the customer may access the mail server using the assigned IP address. (*emphasis added*)

Applicants submit that *Clark* fails to disclose, teach, or suggest at least a “method for blocking unsolicited e-mail transmitted to an e-mail server at an Internet Service Provider (ISP), the method comprising... ***in response to receiving the SMTP traffic, determining, at the e-mail***

*server, whether the customer is associated with a valid IP address...*” as recited in claim 1, as amended. More specifically, *Clark* discloses a “DFF [Dynamic Filtering Firewall] that acts as a barrier to prevent unauthorized access to the OSP subscription services...” (*Clark* col. 4, line 46). For at least the reason that *Clark* does not disclose, teach, or suggest at least this element, Applicants submit that claim 1, as amended is patentable over *Clark*.

**B. Claim 9 is Patentable Over *Clark***

The Office Action indicates that claim 9 stands rejected under 35 U.S.C. §102(e) as allegedly being anticipated by U.S. patent number 6,442,588 to Clark et al. (“*Clark*”).

Applicants respectfully traverse this rejection on the grounds that *Clark* does not disclose, teach, or suggest all of the claimed elements. Claim 9, as amended recites:

A method of preventing unsolicited e-mails from being transmitted via a mail server associated with the Internet Service Provider (ISP) of a customer:

- receiving a user identification (USERID) and password, wherein the USERID and password are associated with the customer;
- authenticating the customer as a registered user of the ISP;
- generating a positive response if the customer is a registered user of the ISP;
- receiving a START record indicating that the customer is being logged onto a Network Access Server (NAS);
- writing the START record to a database;
- receiving SMTP traffic from the customer for delivery to a recipient;

*in response to receiving the SMTP traffic determining, at the mail server, whether an IP address assigned to the customer is valid; and*

*in response to determining that the IP address assigned to the customer is valid, forwarding the SMTP traffic to the recipient. (emphasis added)*

Applicants submit that *Clark* fails to disclose, teach, or suggest at least a “method of preventing unsolicited e-mails from being transmitted via a mail server associated with the Internet Service Provider (ISP) of a customer... ***in response to receiving the SMTP traffic determining, at the mail server, whether an IP address assigned to the customer is valid...***” as recited in claim 9, as amended. More specifically, *Clark* discloses a “DFF [Dynamic Filtering Firewall] that acts as a barrier to prevent unauthorized access to the OSP subscription services...” (*Clark* col. 4, line 46). For at least the reason that *Clark* does not disclose, teach or suggest at least this element, Applicants submit that claim 9, as amended is patentable over *Clark*.

**C. Claim 15 is Patentable Over *Clark***

The Office Action indicates that claim 15 stands rejected under 35 U.S.C. §102(e) as allegedly being anticipated by U.S. patent number 6,442,588 to Clark et al. (“*Clark*”).

Applicants respectfully traverse this rejection on the grounds that *Clark* does not disclose, teach, or suggest all of the claimed elements. Claim 15, as amended recites:

A method of logging on a customer of an Internet Service provider (ISP) onto a mail server while preventing the unauthorized distribution of SPAM messages via the mail server, the method comprising:  
    authenticating that the customer is a registered customer of the ISP;  
    storing a data log in a database, the data log comprising a plurality of attributes to track the customer’s usage of the network connection;  
    receiving SMTP traffic from the customer;  
    ***in response to receiving the SMTP traffic, determining, at the mail server, whether as IP address assigned to the customer is valid; and***  
    in response to determining that the IP address assigned to the customer is valid, connecting the customer to the mail server using the IP address. (*emphasis added*)

Applicants submit that *Clark* fails to disclose, teach, or suggest at least a “method of logging on a customer of an Internet Service provider (ISP) onto a mail server while preventing

the unauthorized distribution of SPAM messages via the mail server, the method comprising... *in response to receiving the SMTP traffic, determining, at the mail server, whether as IP address assigned to the customer is valid...*” as recited in claim 15, as amended. More specifically, *Clark* discloses a “DFF [Dynamic Filtering Firewall] that acts as a barrier to prevent unauthorized access to the OSP subscription services...” (*Clark* col. 4, line 46). For at least the reason that *Clark* does not disclose, teach, or suggest at least this element, Applicants submit that claim 15, as amended is patentable over *Clark*.

**D. Claims 2 – 3, 6 – 7, 10 – 11, 13 – 14, 16 – 17, 19 – 23, and 25 – 27 are Patentable Over *Clark***

In addition, dependent claims 2 – 3, 6 – 7, and 19 – 20 are believed to be allowable for at least the reason that these claims depend from allowable independent claim 1. Further, dependent claims 10 – 11, 13 – 14, and 21 – 23 are believed to be allowable for at least the reason that they depend from allowable independent claim 9. Additionally dependent claims 16 – 17 and 25 – 27 are believed to be allowable for at least the reason that these claims depend from allowable independent claim 15. *In re Fine, Minnesota Mining and Mfg.Co. v. Chemque, Inc.*, 303 F.3d 1294, 1299 (Fed. Cir. 2002).

**IV. Rejections Under 35 U.S.C. §103**

In order for a claim to be properly rejected under 35 U.S.C. §103, the teachings of the cited art reference must suggest all features of the claimed invention to one of ordinary skill in the art. *See, e.g., In re Dow Chemical*, 837 F.2d 469, 5 U.S.P.Q.2d 1529, 1531 (Fed. Cir. 1988); *In re Keller*, 642 F.2d 413, 208 U.S.P.Q. 871, 881 (C.C.P.A. 1981). Further, “[t]he PTO has the burden

under section 103 to establish a prima facie case of obviousness. It can satisfy this burden only by showing some objective teaching in the prior art or that knowledge generally available to one of ordinary skill in the art would lead that individual to combine the relevant teachings of the references.” *In re Fine, Minnesota Mining and Mfg.Co. v. Chemque, Inc.*, 303 F.3d 1294, 1299 (Fed. Cir. 2002).

**A. Claims 4, 5, and 8 are Patentable Over *Clark* in View of *Donaldson***

The Office Action indicates that claims 4, 5, and 8 stand rejected under 35 U.S.C. §102(e) as allegedly being anticipated by U.S. patent number 6,442,588 to Clark et al. (“*Clark*”) in view of U.S. Patent Number 6,321,267 to Donaldson (“*Donaldson*”). Applicants respectfully traverse this rejection on the grounds that *Clark* in view of *Donaldson* does not disclose, teach, or suggest all of the claimed elements. More specifically, dependent claims 4, 5, and 8 are believed to be allowable for at least the reason that these claims depend from allowable independent claim 1. *In re Fine, Minnesota Mining and Mfg.Co. v. Chemque, Inc.*, 303 F.3d 1294, 1299 (Fed. Cir. 2002).

Additionally, the Office Action states “the use of SMTP and timestamps was well known in the art at the time of the invention” (OA p. 5, item 19). Applicants respectfully traverse this alleged finding of well known subject matter and submit that the subject matter noted above should not be considered well known since the Office Action does not include specific factual findings predicated on sound technical and scientific reasoning to support the conclusions, as required.

Applicants assert the subject matter of claims 4, 5, and 8, is not well known and expected in the art. Applicants traverse the alleged finding of well known subject matter, and submit that claims 4, 5, and 8 are patentable over *Clark* in view of *Donaldson*.

**B. Claims 12, 18, and 24 are Patentable Over *Clark* in View of *Amin***

The Office Action indicates that claims 12, 18, and 24 stand rejected under 35 U.S.C. §102(e) as allegedly being anticipated by U.S. patent number 6,442,588 to Clark et al. (“*Clark*”) in view of U.S. Patent Number 6,854,014 to Amin et al. (“*Amin*”). Applicants respectfully traverse this rejection on the grounds that *Clark* in view of *Amin* does not disclose, teach, or suggest all of the claimed elements. More specifically, dependent claims 12 and 24 are believed to be allowable for at least the reason that these claims depend from allowable independent claim 9. Additionally, dependent claim 18 is believed to be allowable for at least the reason that this claim depends from allowable independent claim 15. *In re Fine, Minnesota Mining and Mfg. Co. v. Chemque, Inc.*, 303 F.3d 1294, 1299 (Fed. Cir. 2002).

Additionally, the Office Action states “including [a session ID, account delay time and a start timestamp] in a START record was well known in the art at the time of the invention” (OA p. 6, item 22). Applicants respectfully traverse this alleged finding of allegedly well known subject matter and submit that the subject matter noted above should not be considered well known since the Office Action does not include specific factual findings predicated on sound technical and scientific reasoning to support the conclusions, as required.

Applicants assert the subject matter of claims 12, 18, and 24, is not well known and expected in the art. Applicants traverse the alleged finding of allegedly well known subject matter, and submit that claims 12, 18, and 24 are patentable over *Clark* in view of *Anin*.

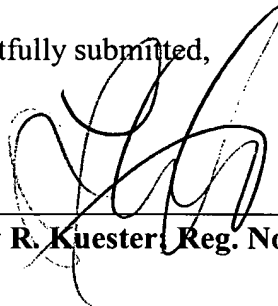
## CONCLUSION

In light of the foregoing amendments and for at least the reasons set forth above, Applicants respectfully submit that all objections and/or rejections have been traversed, rendered moot, and/or accommodated, and that the now pending claims are in condition for allowance. Favorable reconsideration and allowance of the present application and all pending claims are hereby courteously requested.

Any other statements in the Office Action that are not explicitly addressed herein are not intended to be admitted. In addition, any and all findings of inherency are traversed as not having been shown to be necessarily present. Further, any and all findings of well-known art and official notice, or statements interpreted similarly, should not be considered well known since the Office Action does not include specific factual findings predicated on sound technical and scientific reasoning to support such conclusions.

If, in the opinion of the Examiner, a telephonic conference would expedite the examination of this matter, the Examiner is invited to call the undersigned attorney at (770) 933-9500.

Respectfully submitted,



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